

REMARKS

I. THE EFFECTS OF THE PATENT OFFICE'S POSITION ARE VARIOUS
ADMISSIONS CONCERNING PATENTABILITY

The effect of the position in the Office Action is that the Patent Office admits that each Group (I-III) of claims are patentable over a disclosure of the combination of the other claims, and *vice versa*. M.P.E.P. 802.01 states that **the distinctness required for restriction means that the subjects, including "process and apparatus for its practice ... ARE PATENTABLE (novel and unobvious) OVER EACH OTHER"** (emphasis with capital letters in original). (See also M.P.E.P. 808.02, which states that where "related inventions are not patentably distinct as claimed, restriction ... is never proper." The Patent Office has also stated that "it is imperative the requirement should never be made where related inventions as claimed are not distinct." M.P.E.P. 806.)

Thus, the effect of this restriction requirement, unless withdrawn, is that the Patent Office admits that the claims of Group I claim are patentable over the Group II and III claims. *See, e.g.*, M.P.E.P. 802.01. Likewise, the effect of this restriction requirement, unless withdrawn, is that the Patent Office admits that the Group II claims are patentable over Group I and III claims, and that the Group III claim is patentable over the Group I and II claims. *Id.*

These positions are necessary to entry of the restriction requirement by the Patent Office and may be relied upon by the applicants during examination of this and continuing applications, unless the restriction requirement is withdrawn. If the examiner is not taking these positions, then it is submitted that the restriction requirement should be withdrawn upon reconsideration.

II. THE RESTRICTION REQUIREMENT SHOULD BE WITHDRAWN BECAUSE
THE EXAMINER HAS FAILED TO DEMONSTRATE THAT THE INVENTIONS
ARE INDEPENDENT

The examiner also states that Groups I and II are distinct because "the apparatus can be used to practice another and materially difficult process" *See*, Office Action at page 2.

The provisions of 35 U.S.C. §121 state, "If two or more *independent and distinct* inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions." (Emphasis added.) In the Office Action, the examiner

has failed to demonstrate or assert that the claims of Group I are "independent" from the claims of Group II.

According to M.P.E.P. §802.01, "[t]he term "independent" (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation or effect" However, the examiner acknowledged that Groups I and II are related as process and apparatus for its practice. The existence of these relationships suggests that the statutory requirement for independence has not been satisfied. Thus, the examiner has failed to meet the burden for imposing restriction.

III. THE STANDARD FOR REQUIRING RESTRICTION HAS ALSO NOT BEEN MET BECAUSE SEARCH AND EXAMINATION OF THE ENTIRE APPLICATION CAN BE MADE WITHOUT SERIOUS BURDEN ON THE EXAMINER

The restriction requirement is improper on its face because it does not meet the requirement that search and examination of the entire application must be a serious burden on the examiner. M.P.E.P. 803 states:

"If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions."

The Applicants thus further traverse the restriction requirement on the ground that there is no evidence, or even allegation, that search and examination of the entire application would be a *serious burden* on the examiner, as required.

Since search and examination of the entire application can be made without serious burden on the examiner, it would be wasteful of the time, effort, and resources of both the Applicants and the Patent Office to prosecute these claims in separate applications. Indeed, with respect to Groups I and II, the examiner states that all of claims 1-33 are "classified in class 244, subclass 164." *See*, Office Action at page 2. Search and examination of the three groups of claims together would be much more efficient than requiring the Patent Office and the Applicants to do so separately in multiple applications.

IV. PROVISIONAL ELECTION

To satisfy 37 C.F.R. 1.143, the applicants hereby provisionally elect for examination on the merits, with traverse, the claims of Group I, i.e., claims 1-24 and 27-32. In so doing, the Applicants do not intend to abandon the scope of the non-elected claims as originally filed, but may pursue the non-elected claims in a divisional application if the restriction requirement is not withdrawn upon reconsideration.

No additional fee is believed due at this time. However, the Commissioner is hereby authorized to charge any fee deficiency, or to credit any overpayments, to Deposit Account No. 13-2855 of the undersigned's firm.

Respectfully submitted,

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